THREE V MARKETING SDN BHD

v.

HENG CAPITAL INDUSTRIES (M) SDN BHD; THE REGISTRAR OF INDUSTRIAL DESIGNS (INTERESTED PARTY)

HIGH COURT MALAYA, KUALA LUMPUR
AZAHAR MOHAMED J
[NOTICE OF MOTION NO: D-25IP-3-2009]
6 NOVEMBER 2009

PATENTS: *Industrial designs - Registered designs - Revocation of registration, application for - Whether there was prior disclosure to public - Disclosure to public, how effected - Industrial Designs Act 1996 ss. 12 & 27*

PATENTS: *Industrial designs - Registered designs - Whether design was 'new' within meaning of s. 12 of the Industrial Designs Act 1996 - Design similar to earlier registered design but with differences - How differences ascertained - Industrial Designs Act 1996 s. 12*

WORDS AND PHRASES: *'new' - Industrial Designs Act 1996 s. 12*

The applicant's industrial design was known as the 'T-shape connector' ('the applicant's design') and was filed for registration on 15 August 2003. The applicant obtained registration of the same on 2 April 2004. The respondent filed its own design ('the respondent's design') on 23 June 2004 and obtained registration of the same on 18 March 2005. The respondent's design was filed in respect of 'decorative edgings for furniture'. The applicant subsequently applied to revoke the registration of the respondent's design pursuant to s. 27(1) of the Industrial Designs Act 1996 ('the Act'). The applicant's application was based on, *inter alia*, the following grounds: (i) the respondent's design was identical or had a substantial and/or material similarity with the applicant's design; (ii) the respondent's design was an obvious and/or fraudulent imitation of the applicant's design; and (iii) the respondent's design was not a new design within the contemplation of s. 12 of the Act. The respondent, however, opposed the applicant's application on several grounds. The respondent's counsel submitted that the applicant's design was for the registration of a 'clothes dryer' whereas the respondent's design was for 'decorative edgings for furniture'. The designs were thus not substantially similar.

Held (dismissing the application with costs):

(1) Disclosure to the public within the meaning of s. 12(2)(a) of the Act may be effected by: (i) by prior use of the design, by selling or displaying to the public an article to which the design had been applied; or (ii) by prior publication in documents. In the instant case, it was not disputed that 'clothes-hangers' based on the applicant's design had been sold to various shops since 10 December 2003. There had also been disclosure by prior publication in documents. *Rosedale Associated Manufacturers Ltd v. Airfix Ltd* (foll). (paras 20-24)

(2) Since the applicant's prior design had been identified, it was necessary to evaluate the respondent's design to see if it was 'new' within the meaning of s. 12 of the Act. If the respondent's design was identical in all respects to the applicant's prior design, the respondent's design would not obviously be 'new'. However, if the respondent's design was generally similar to the applicant's prior design but with certain differences, it was necessary to ascertain whether the differences were immaterial details; and whether the differences were merely variants commonly used in the trade. If the differences were immaterial details and constituted variants commonly used in the trade, then the respondent's design would not be new. *Wells v. Attache Case Manufacturing Co Ltd* (foll); *Amp Incorporated v. Utilux Pty Limited* (foll). (paras 26-31)

(3) The applicant's design was clearly and unmistakably different from the respondent's design. There were no material similarities between the designs. They were not identical. The respondent's design was thus 'new' within the meaning of s. 12 of the Act. (paras 34-37)

Case(s) referred to:
Amp Incorporated v. Utilux Pty Limited [1970] RPC 397
Rosedale Associated Manufacturers Ltd v. Airfix Ltd [1957] RPC 239
Wells v. Attache Case Manufacturing Co Ltd [1932] 49 RPC 113

Legislation referred to:
Industrial Designs Act 1996, ss. 12(1), (2)(a), 22, 27(1)

Other source(s) referred to:
Russell-Clarke and Howe on Industrial Designs, 7th edn, para 3-152

For the applicant - MK Lam; M/s V Chong W Lam
For the respondent - SF Wong (Sri Dhevi with him); M/s Shearn Delamore & Co

Reported by Andrew Christopher Simon

JUDGMENT

Azahar Mohamed J:

[1] This case is concerned with one of our intellectual property laws employed to protect industrial design. Generally the art of designing is concerned with the appearance of an article or product.

[2] By this notice of motion in encl. 1, the applicant is seeking the following prayers against the respondent:

(a) The Industrial Design Registration No. MY 04-00413 (the respondent's MY 04-00413) for "Decorative Edgings For Furniture" under the respondent's name be revoked and removed from the Register of Industrial Designs of Malaysia;

(b) If prayer (1) is allowed, a copy of the sealed order be delivered to the Registrar of Industrial Designs pursuant to the Industrial Designs Regulations 1999 and that the Registrar of Industrial Designs revokes the respondent's MY 04-00413 and thereafter cause to be published a statement to that effect in the Gazette;

(c) That costs of and in relation to this application be borne by the respondent.

[3] For easy reference, the representation of the design found in the respondent's MY 04-00413 is reproduced in Annex A to this judgment.

[4] The applicant's application is founded on the following principal grounds. The applicant is the assignee of the Industrial Design Registration No. MY 03-00515 (the applicant's MY 03-00515) which has a filing date of 15 August 2003 and it was granted on 2 April 2004. For easy reference, the representation found in the applicant's MY 03-00515 is reproduced in Annex B to this judgment. The filing date of the respondent's MY 04-00413 is 23 June 2004 and it was granted on 18 March 2005. Hence,

A according to the applicant, the respondent's MY 04-00413 has been disclosed to the public prior to the priority date of the application. The applicant's main contention is that on 23 June 2004 the respondent's MY 04-00413 is not a new design within the meaning of s. 12(1) of the Industrial Designs Act 1996 (the Act).

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[5] The applicant's application is pursuant to s. 27(1) the Act which reads as follows:

> 27. Revocation of registration and grant of compulsory licence.
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> C (1) At any time after the registration of an industrial design, any person may apply to the Court
>
> (a) for the *revocation of the registration of the industrial design on the ground, subject to section 12, that the industrial design has been disclosed to the public prior to the priority date of the* D *application for registration of the industrial design*; (emphasis added)
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> (b) for the cancellation of the registration of the industrial design on the ground that the registration of the industrial design has been procured by unlawful means; or
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> E
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> (c) for the grant of a compulsory licence in respect of the industrial design on the ground that the industrial design is not applied in Malaysia by any industrial process or means to the article in respect of which it is registered to such an extent as is reasonable in the circumstances of the case,
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> and the Court may make such order on the application as it considers just.

[6] Section 12 of the Act provides for a registrable industrial G design:

> (1) Subject to this Act, an industrial design shall not be registered unless it is new.
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> (2) **An industrial design** for which an application for registration H is made *shall not be considered to be new if, before the priority date of that application, it or an industrial design differing from it only in immaterial details or in features commonly used in the relevant trade*: (emphasis added)
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> (a) was disclosed to the public anywhere in Malaysia; or
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(b) was the subject matter of another application for registration of an industrial design filed in Malaysia but having an earlier priority date made by a different applicant in so far as that subject matter was included in a registration granted on the basis of that other application.

(3) For the purposes of paragraph (2)(a), an industrial design shall not be deemed to have been disclosed to the public solely by reason of the fact that, within the period of six months preceding the filing date of an application for registration:

(a) it appeared in an official or officially recognized exhibition; or

(b) it has been disclosed by a person other than the applicant or his predecessor in title as a result of an unlawful act committed by that other person or another person).

The Applicant's Case

[7] The applicant's notice of motion is supported by two affidavits affirmed by Puah Cheok Peng (encls. 2 and 7).

[8] The applicant is a private limited company incorporated under the Companies Act 1965 and its registered address is at No. 271 Room A, Jalan Maarof, Bangsar, 59000 Kuala Lumpur and its business address at Lot 1857 and 8381, Kawasan Perusahaan Bukit Angkat, Sg. Chua, and Kajang 43000 Selangor Darul Ehsan. Since its incorporation on 7 April 1994 until today the applicant has specialized in the production, manufacture, distribution, sale and/or dealings with furniture. On 2 April 2004, the applicant entered into a deed of assignment with Innovative Knowledge Sdn Bhd to own the rights to a design claimed under applicant's MY 03-00515. Since December 2003, the applicant has been producing, manufacturing, distributing, offering for sale and/or selling articles to which the applicant's MY 03-00515 has been applied by an industrial process.

[9] According to the applicant, the respondent's drawing in MY 04-00413 is identical or has a substantial and/or material similarity with the design as claimed in MY 03-00515 by the applicant.

[10] The applicant's case is that the respondent's MY 04-00413 is an obvious and/or fraudulent imitation of the applicant's MY 03-00515 and the respondent's MY 04-00413 ought to be revoked and removed from the Register of Industrial Designs of Malaysia. Furthermore, since the applicant's application has been filed in Malaysia on 15 August 2003, the respondent's MY 04-00413 is not a "new" design within the meaning of s. 12(1) of the Act 1996 and as such, not qualified to be registered as a design.

[11] According to the applicant, the respondent's MY 04-00413 is a reproduction of the whole and/or a substantial part of the drawings which are artistic works, the copyright of which belongs to the applicant. The acts of the respondent in reproducing the whole and/or a substantial part of the applicant's artistic works is an infringement of the applicant's copyright in the said artistic works. Since the respondent's MY 04-00413 infringes the applicant's copyright in the said artistic works, the respondent's MY 04-00413 is not qualified to be registered as a design.

[12] The applicant claims that the part of the applicant's MY 03-00515 which is known as the T-Shape Connector is copied substantially by the respondent and it is registered as the respondent's MY 04-00413.

[13] Ms MK Lam, learned counsel for the applicant argued that the respondent's MY 04-00413 is not new for the reason that the applicant's MY 03-00515 has been applied to articles, namely "Clothes Dryer" referred to as "12 Bars Fan Hanger". Learned counsel emphasized the point that the applicant is the registered owner of MY 03-00515 which has a filing date of 15 August 2003. Furthermore, she argued that that the "Clothes Dryer" referred to as "12 Bars Fan Hanger" have been sold to various furniture shops since as early as 10 December 2003. Learned counsel then argued that the applicant's MY 03-00515 clearly shows six pairs of the plastic T-shape connectors, which she contended is in fact the subject matter of the respondent's MY 04-00413. She then invited this court to see for itself that both the plastic T-shape connectors of the applicant's MY 03-00515 and the respondent's MY 04-00413 are nearly identical. As a final point, learned counsel argued that the respondent's MY 04-00413 is not new and ought to, on that ground, be revoked.

The Respondent's Case

[14] In opposing the applicant's motion, the respondent filed an affidavit affirmed by Heng Lip Bak (encl. 6).

[15] According to the respondent, the article that has been registered under the applicant's MY 03-00515 is "Clothes Dryer" which was when applied for and still is not an industrial design within the intent and meaning of 'an industrial design' as defined under the Act in that:

(a) The design that is claimed in the applicant's MY 03-00515 is not applied to the article and the article is also devoid of any design that can appeal to or capable of being judged by the eye;

(b) The article consists of only general features of shape and configuration which is nothing more that a method or principle of construction and it does not more that merely identify general characteristics of shape;

(c) The design as applied to the article is unavoidably necessary for the task or function it has to perform;

(d) The appearance of the article as depicted is not a material factor in its purchase or use; and

(e) The article consists of parts individually manufactured for assembly and each composite piece is intended to fit into other pieces to form an integral working piece of the clothes hanger.

[16] Furthermore, according to the respondent, the applicant's MY 03-00515 did not meet the statutory requirements for registration required by s. 12 of the Act because of the following reasons:

(a) At the priority date of the applicant's MY 03-00515 there were other clothes hangers available in the market which differed from the clothes hangers of the applicant's registered design only in immaterial details;

(b) That the article as depicted in the applicant's MY 03-00515 consists of only trivial and unimportant differences and is substantially the same as those already available in the market;

(c) The differences if any are wholly functional to enable the clothes hanger to function as it is intended to allow the clothes that is hung on it to dry; and

(d) The applicant's MY 03-00515 is only a trade variant or obvious adaptation of those already existing in the relevant market or before the application date of the applicant's MY 03-00515.

[17] The respondent contends that the applicant's MY 03-00515 is not valid and therefore there is no justification for the applicant to apply to expunge the respondent's MY 04-00413 from the Registrar of Industrial Design of Malaysia.

[18] Moreover, according to the respondent, the applicant's MY 03-00515 is for the registration of the "Clothes Dryer" as a whole whereas the respondent's MY 04-00413 is for "Decorative Edgings for Furniture". The shape and configuration of the article sought to be protected by the applicant's MY 03-00515 is that of the "Clothes Dryer" as a whole and not any particular part thereof. In any event, none of the drawings in the applicant's MY 03-00515 show the features of the "Decorative Edgings for Furniture" as claimed by the respondent's MY 04-00413.

[19] The respondent has raised many grounds in its affidavit in opposing the applicant's motion. However, Mr. SF Wong, learned counsel for the respondent in his submission only raised one issue and it is that the applicant's MY 03-00515 is for the registration of the "Clothes Dryer" as a whole whereas the respondent's MY 04-00413 is for "Decorative Edgings for Furniture". For this reason, he argued that it cannot be said the respondent's MY 04-00413 is substantially similar to the applicant's MY 03-00515. To end his submission, Mr. SF Wong argued that the respondent's design of MY 04-00413 is "new" within the meaning of s. 12 of the Act.

Findings Of Court

[20] To begin with, I shall deal with the question as to what constitutes public disclosure pursuant to s. 12(2)(a) of the Act.

[21] Now, there are two ways in which the requirements of s. 12(2)(a) of the Act for "disclosure to the public anywhere in Malaysia" are fulfilled and they are namely: (i) by prior use of the design, by selling or displaying to the public an article to which the design has been applied; and (ii) by prior publication in documents.

[22] I find it useful to reproduce the principles as summarized in *Russell-Clarke and Howe on Industrial Design* (7th edn): A

> Prior publication of a design by prior use can be said to take place when the design has been applied to articles, and those articles have been used in such a way that the design becomes disclosed to the public before the date of application for registration of the design in suit. It should be noted that it is sufficient if the design is used on any kind of article, and it need not be the same article, or even in the same category, as the article in respect of which the design is registered or sought to be registered. B
>
> In general there will be publication if articles to which the design is applied are manufactured, displayed or used in such a way that members of the public will or might see them. It is not necessary that the articles should been sold. Prior use thus means not use by the public, but use in public as opposed to use in private. C D

[23] In the present case, it is not disputed that the clothes dryers have been sold to various furniture shops since as early as 10 December 2003. Furthermore, there has been disclosure by prior publication in documents. It cannot be disputed that the applicant has applied for registration of its "Clothes Dryer" *via* MY 03-00515 on 15 August 2003 and it was granted on 2 April 2004. On the other hand, the respondent has applied for registration of its "Decorative Edgings For Furniture" *via* MY 04-00413 on 23 June 2004 and it was granted on 18 March 2005. Pursuant to s. 22 of the Act upon registering an industrial design the same is recorded in the register and published in the Gazette. The register is open to searches by the public. According to learned counsel for the applicant, within the said registration there are clear photographs depicting the said "Clothes Dryer" and the T-shaped connectors which form part and parcel of the said "Clothes Dryer". E F G

[24] Lord Evershed MR in *Rosedale Associated Manufacturers Ltd v. Airfix Ltd* [1957] RPC 239 held at p. 244:

> In this respect the test of prior publication of an alleged invention should, in my judgment, be no less applicable in the case of a registered design, and as regards the former, I venture to cite once more the oft-quoted language of Lord Westbury in *Hills v. Evans*: 'The antecedent statement must, in order to invalidate the subsequent patent, be such that a person of ordinary knowledge of the subject would at once perceive and understand and be able H I

A practically to apply the discovery without the necessity of making further experiments.' By a like reasoning, to my mind, *if a document is to constitute prior publication, then a reader of it, possessed of ordinary knowledge of the subject, must from his reading of the document be able at least to see the design in his mind's eye and should not have to depend on his own originality to construct the design from the ideas which the document may put into his head*. (emphasis added)

B

[25] Next, I move on to deal with the issue of assessing the novelty of the respondent's design of MY 04-00413 against the prior design ie, the applicant's design of MY 03-00515.

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[26] Once the applicant's prior design of MY 03-00515 has been identified, it now becomes necessary to compare the respondent's design of MY 04-00413 in order to see whether or not the latter is "new" within the meaning of s. 12 of the Act. If after comparison it is revealed that the respondent's design of MY 04-00413 is identical in all respect to the applicant's prior design of MY 03-00515, the respondent's design of MY 04-00413 is obviously not "new". However, the respondent's design of MY 04-00413 may be generally similar to the applicant's prior design of MY 03-00515, but there may be certain differences. If so, two questions will need to be asked:

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(a) Are the differences "immaterial details"?

(b) Are the differences merely in features which "are variants commonly used in the trade"?

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[27] If all the differences can be categorized either as immaterial details, or as variants commonly used in the trade, then the respondent's design of MY 04-00413 is not new.

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[28] In *Wells v. Attache Case Manufacturing Co Ltd* [1932] 49 RPC 113 Luxmoore J held at p. 119:

> The final decision must be the general impression gathered by the instructed eye of the Court. Obviously slight variations of designs already in use cannot be the subject-matter of valid registration. The variation in what has gone before, unless it differs from what has been made before by something more than ordinary trade variants, must be plain.

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[29] A useful summary from *Russell-Clarke and Howe on Industrial Designs* (7th edn) para. 3-152 reads as follows: A

> The question which has to be decided is whether the two appearances are substantially the same or not. That the eye, and the eye alone, is to be the judge of identity, and is to decide whether one design is or is not an anticipation of another, has been consistently laid down. The design must be looked at as a whole, the question being whether an article made according to the design under consideration is substantially similar in appearance to an article made according to the alleged anticipation. The test is not only to look at the two design side by side, but also apart, and a little distance away. The novelty should in other words be substantial ... B C

[30] Further on this point, the English Court of Appeal in the case of *Amp Incorporated v. Utilux Pty Limited* [1970] RPC 397 at p. 430 held: D

> There is a long line of authorities from *Le May v. Welch* [1885] 28 Ch.D. 24 at 34 onwards, including such a case as *Allen West v. British Westinghouse Electric & Manufacturing* [1916] 33 RPC 157 at 165, which have laid down that to qualify as new or original a design must, when compared with the design of prior articles and other registered designs and published matter, show a substantial difference. Novelty or originality must be substantial, that is, must be present as a matter of substance, having regard to the nature of the article. E

[31] These are the principles which I would act upon in the present case. F

The critical question which has to be decided is whether the appearances of the applicant's design of MY03-00515 and the respondent's design of MY 04-00413 are substantially the same in order to see if the respondent's design of MY 04-00413 is "new" within the meaning of s. 12 of the Act. G

[32] By comparing the applicant's design of MY 03-00515 and the respondent's design MY 04-00413, my findings are as follows. H

[33] The starting point is the design as a whole. What is depicted and described in the applicant's design of MY 03-00515, as it can be seen in Annex B, are features of shape and configuration which are applied to clothes dryers. On that note, it is pertinent to observe that the statement of novelty in the applicant's design of I

A MY 03-00515 is declared as "the novelty of the design resides in the shape and configuration of the article as shown in the accompanying representations"; the article therein refers to a "Clothes Dryer". As a whole, the design gives you an idea about a type of collapsible clothes dryer or drying racks. The dryer has a B pair of fan-like frame consists of a series of metal tubes. These tubes are joined together that they form a pattern of three diamond shapes. The connectors are attached to the six pairs of the ends of the metal tubes and two horizontal bars are then affixed to each pair of the connectors. It has 12 bars. This "Clothes Dryer" has a C pair of legs with castors. The "Clothes Dryer" in its assembled form comprises many components parts assembled together to give the assembled "Clothes Dryer" with a function which is for drying clothes.

D **[34]** By contrast, taken as a whole, I consider the overall impression of the design of the applicant's MY 03-00515 clearly and unmistakably differ from that produced by the respondent's design of MY 04-00413 as it can be seen in Annex A. The statement of novelty in the respondent's design of MY 04-00413 is declared as E "the novelty of the design resides in the features of the shapes and configuration applied to the article as shown in the representation"; the article therein refers to 'Decorative Edgings for Furniture'. For one thing, the most glaring difference between the two designs is the fact that the respondent's design of MY 04-00413 is not that F of clothes dryer; in this context it goes without saying that the respondent's design of MY 04-00413 is of course not able to hang and dry clothes. For another thing, the respondent's design of MY 04-00413 for 'Decorative Edgings for Furniture' represents a curved connector which has two end sockets and it also a central G socket. It may also be said, as it can be seen in Annex A, the respondent's design of MY 04-00413 has its own detailed appearance of the connector. Indeed all of these go to show that the two appearances in the design of the applicant's MY 03-00515 and the respondent's design of MY 04-00413 are not substantially the same.

H **[35]** What is more, as a matter of fact, I consider the visual appearance of the connector of the applicant's design MY 03-00515 is not the dominant or the overriding features of the design. I cannot think that the connector is a special or striking feature of the design of the clothes hanger or it is commercially significant. I

The point to make here is this: as it can be seen in Annex B, the applicant's design of MY 03-00515 represents various features of shape and configuration which are applied to clothes dryer. This must be emphasized given that the applicant's design of MY 03-00515 does not focus on the detailed feature of the connector. I may add that it does not provide the overall distinctive appearance of the connector; and it does not give precise and explicit features of the shape and configuration of the connector. Bearing these matters in mind, this is unlike the respondent's design of M Y04-00413 which I have said earlier has a specific appearance. And herein lays the difference.

[36] For this reason, I am unable to say that there are material similarities between the respective designs of the connectors of the applicant's MY 03-00515 and the respondent's design of MY 04-00413 for "Decorative Edgings for Furniture". I am also unable to state that the respondent's design of MY 04-00413 is identical in all respect to the applicant's MY 03-00515, which has been identified as the prior design. All the more so, I think learned counsel for the applicant was wrong to say, "the applicant's T-Shape connector is nearly identical with the respondent's purported design for Decorative Edgings for Furniture".

[37] As a result, I am unable to agree with the submission of learned counsel for the applicant that the applicant's MY 03-00515 disclosed the respondent's MY 04-00413 before the filing date 23 June 2004. In my judgment, the respondent's MY 04-00413 is "new" within the meaning of s. 12 of the Act.

[38] That being the case, I see no alternative but to dismiss the applicant's motion with costs. I fix costs in the sum of RM10,000 to be paid by the applicant to the respondent.

Annex A

The Respondent's Industrial Design Registration No. MY04-00413
"Decorative Edgings For Furniture"

1.1 Perspective View

1.2 Top View

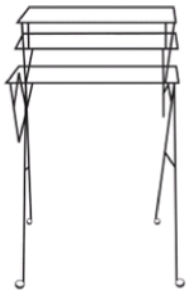
1.3 Bottom View

1.4 Front View

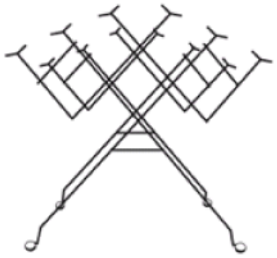
Annex A

The Applicant's Industrial Design Registration No. MY03-00515

"Clothes Dryer"



1.1 Front View



1.2 Side View

1.3 Perspective View